

### Remarks

The present Amendment is being filed together with a "Request for Continued Examination (RCE) Transmittal", as a submission pursuant to 37 C.F.R. §1.114(c). Reconsideration of this Patent Application is respectfully requested.

The Office Action mailed June 9, 2010, accepts the request for continued examination (RCE) submitted on May 25, 2010, and enters the accompanying submission, an Information Disclosure Statement. The Office Action of June 9, 2010, then presents a final rejection of the pending claims for reasons stated from page 3 to page 21 of the Office Action.

The Office Action first restates the earlier withdrawal of claims 39 to 45 from consideration as being directed to what has been characterized as a non-elected invention. Applicants respectfully traverse the Examiner's characterization of newly presented claims 39 to 45. Nevertheless, claims 39 to 45 have been amended to more clearly present apparatus claims, leaving this issue moot.

The Office Action next presents various rejections of applicants' claims including a rejection of claims 1 to 18 under 35 U.S.C. §112, first paragraph, for failing to comply with the enablement requirement, and various rejections of claims under 35 U.S.C. §103(a). Claims 1 to 5 and 7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over a proposed combination

of Fulmer (US 5,242,253) and Kibblewhite (US 5,131,276). Claim 6 stands rejected under 35 U.S.C. §103(a) as being unpatentable over the proposed combination of Fulmer and Kibblewhite, in further combination with Sanduja et al. (US 6,726,960), and claims 8 and 9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the proposed combination of Fulmer and Kibblewhite, in further combination with Hoffmeister et al. (WO 00/63565). Claims 10 to 14 and 16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the proposed combination of Fulmer and Kibblewhite. Claim 15 stands rejected under 35 U.S.C. §103(a) as being unpatentable over the proposed combination of Fulmer, Kibblewhite and Sanduja et al., and claims 17 and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the proposed combination of Fulmer, Kibblewhite and Hoffmeister et al.

Discussion directed to each of these formulated rejections, for purposes of overcoming the stated rejections, has been presented in earlier-submitted papers. Consequently, such discussion is not being restated in this Amendment, but rather is incorporated by reference as if fully set forth herein. The following discussion is additionally presented to supplement this earlier discussion.

Applicants' claims have been amended to more clearly indicate that such claims are directed to an apparatus including an ultrasonic transducer coupled with a thread-forming fastener,

for making precise and reliable ultrasonic load measurements in the thread-forming fastener, and a method of making such a load indicating, thread-forming fastener. It is respectfully submitted that this serves to even further distinguish applicants' claims from the citations identified in the Office Action.

It has previously been acknowledged that the person of ordinary skill in the art at the time applicants' invention was made would have known about thread-forming fasteners, such as those disclosed by Fulmer, and would have also known about ultrasonic transducers, such as those disclosed by Kibblewhite. The person of ordinary skill in the art at the time applicants' invention was made also would have known techniques for applying ultrasonic transducers to conventional fasteners, such as those disclosed by Kibblewhite. What the person of ordinary skill in the art would not have known at the time applicants' invention was made was that an ultrasonic transducer should be applied to a thread-forming fastener, in accordance with applicants' claims. As a consequence, while the person of ordinary skill in the art at the time applicants' invention was made would have known about the separate components recited in applicants' claims, at the time applicants' invention was made, the person of ordinary skill in the art would not have known to combine them in the manner recited.

It is respectfully submitted that it follows from this that applicants' specification "contained sufficient information

regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention" which, noting Section 2164.01 of the Manual of Patent Examining Procedure, is sufficient to satisfy the enablement requirement of 35 U.S.C. §112, first paragraph, overcoming the rejection of claims formulated on this basis.

It is further respectfully submitted that it also follows from this that under the "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*" (OG Notices: 06 Nov 2007), "combining known prior art elements is not sufficient to render the claimed invention obvious if the results would not have been predictable to one of ordinary skill in the art". As a consequence, it is respectfully submitted that the proposed combination of Fulmer and Kibblewhite presented in the Office Action of June 9, 2010, does not satisfy these Examination Guidelines, overcoming the rejection of applicants' claims under 35 U.S.C. §103(a).

Further support for this conclusion is supplied when considering the Declarations which had previously been submitted in this matter. The Declarations demonstrate an unsolved need and a failure of others to satisfy that need, which supports a finding of patentability under *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). The Declarations also demonstrate that the claimed invention yields unexpected properties not present in


the prior art, which supports a finding of patentability under *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990). Moreover, such conclusions are "based on evidence [presented in the Declarations], not argument or speculation", meeting the requirements of *In re Mayne*, 104 F.3d 1339, 41 USPQ2d 1451 (Fed. Cir. 1997).

Accordingly, it is submitted that applicants' claims were originally in condition for allowance, and continue to be in condition for allowance.

Entry of the present Amendment, and a favorable consideration of this Patent Application in view of the foregoing, is respectfully requested. Also to be noted is that corrective amendments have been made to claims 29 and 30, which currently stand withdrawn from consideration.

An Information Disclosure Statement has also been enclosed with the submitted "Request for Continued Examination (RCE) Transmittal", as a further submission pursuant to 37 C.F.R. §1.114(c). Entry and consideration of the enclosed Information Disclosure Statement is further respectfully requested.

Respectfully submitted,

  
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